

Appl. No. 09/890,921  
Atty. Docket No. CM-2038  
Amdt. dated 03/01/2004  
Reply to Office Action of 8/29/2003  
Customer No. 27752

### REMARKS

Claims 1-6 and 10-15 are pending in the present application. No additional claims fee is believed to be due.

Claim 15 has been amended by addition of the phrase "addition to the composition of" at line 2.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

#### Rejection Under 35 USC 112, First Paragraph

The Office Action states "Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete because the claim fails to recite any active method step." Claim 15 has been amended by addition of the phrase "addition to the composition of". This amendment should provide the active step requested.

#### Rejection Under 35 USC 102 Over US 6,024,942 (Tanner)

Claims 1-6, 10-11 and 13-15 have been rejected under 35 USC 102 as being unpatentable over Tanner et al. (US 6,024,942).

The amended claims require the use of water-swellaable cationic polymers. While many cationic polymers have been utilized as thickeners, only those which are water-swellaable are claimed by the instant application. The essence of the instant invention is the production of compositions with low levels of tack. As is stated at page 2, lines 20-26 of the application: "...compositions comprising polymeric thickening agents often suffer negatives following application to the skin in aqueous solution, forming networks and building viscosity. When such compositions are applied to the skin, the evaporation of water leads to an increase in the effective concentration of polymeric thickening agent...and the perceived tackiness of the residue." The use of water-swellaable cationic polymers, rather than the general class of cationic polymers, in order to produce compositions with reduced tack, is not contemplated in the citation.

#### Rejection Under 35 USC 103(a) Over US 6,024,942 (Tanner)

Claims 1-6, 10-11 and 13-15 have been rejected under 35 USC 103(a) as being unpatentable over Tanner et al. (US 6,024,942).

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As pointed out above, the use of water-swellaable cationic polymers to reduce the levels of tack in leave-on cosmetic compositions, is not contemplated in Tanner. Given the use of the general class of polymers, it would not be obvious to one of skill in the art to select water-swellaable cationic polymers to produce an improvement in the level of tack in such compositions.

There are three basic criteria for establishing a case of *prima facie* obviousness, as stated in the MPEP 2142 "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the references. Second, there must be a reasonable expectation of success, Finally, the prior art references must teach or suggest all the claim limitations." Not only are the instant claim limitations not taught in Tanner, but there would be no reason for those of skill in the art to expect that the use of water-swellaable cationic polymers in combination with polyacrylamides would result in a leave-on cosmetic composition with reduced tack.

#### Rejection Under 35 USC 103(a) Over WO 9603967 (Jones)

While the Office Action does not rely upon the above-referenced document, it is discussed with regard to the instant claims.

The Office Action states "It may be noted that the polymeric materials taught in the prior art are the polymeric materials taught in the invention and thus should have glass transition temperature of less than 0°C or the same glass transition temperature as that recited in the instant claim." However, polymers with identical monomer(s) and identical molecular weight(s) can have very different glass transition temperatures depending upon a number of factors. One such factor is the level of branching within the polymer. Branched polymers, such as those used in the instant invention, remain flexible at temperatures which result in more linear polymers becoming rigid or "glassy". In other words, very low temperatures would be required before their structures become rigid. On the other hand, cationic hair fixative polymers, such as as used by Jones, have higher glass transition temperatures appropriate to the function holding the hair in a particular configuration. Therefore, Jones does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03).

#### Conclusion

In light of the remarks and amendments, Applicants respectfully submit that the applied reference does not disclose or render obvious Claims 1-6 and 10-15. Accordingly,

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favorable reconsideration of Claims 1-6 and 10-15 is earnestly solicited in the form of a Notice of Allowance.

Should any issues impeding continuing examination of this Application remain, the Examiner is encouraged to contact the undersigned by telephone at the earliest possible date to achieve a timely resolution.

Respectfully submitted

FOR: MICHAEL DAVID BELL, ET AL

By \_\_\_\_\_

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